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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,491	06/26/2001	Pai-Chin Wu	WUPA3001/EM/6926	9102

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EXAMINER	
PHAN, TRI H	

ART UNIT	PAPER NUMBER
2616	

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/888,491	WU ET AL.	
	Examiner	Art Unit	
	Tri H. Phan	2661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 November 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) *1-3* is/are allowed.

6)☐ Claim(s) *4-6* is/are rejected.

7)☐ Claim(s) *7* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment/Arguments

1. This Office Action is in response to the Response/Amendment filed on November 16th, 2005. Claims 1-7 are now pending in the application.

Drawings

2. The replacement sheet of drawings (figures 1 and 2) was received on November 16th, 2005. These drawings are acceptable.

Claim Objections

3. Claims 1-7 are objected to under 37 C.F.R 1.75 because of the following formalities:

In the preamble of claims 1-7, the terms "capable of" is not a positively recited limitation.

In claim 1, line 9, the word "the" in front of the phrase "at least one subscriber line interface circuit" should be deleted for clarity.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ng et al.** (U.S.6,424,647; hereinafter refer as '**Ng**').

- In regard to claim 4, Ng discloses, *a method for a voice over internet protocol device auto-selectively dialing up a public switched telephone network or an internet phone* ('Internet phone 103' in figures 1-2), *comprising the steps of causing a line transfer switch* ('relay 201' in figures 2, 8) *to connect a subscriber line interface circuit* ('audio interface circuitry' in the Internet phone 103; for example see col. 4, lines 54-57) *with at least one terminal apparatus* ('phone 101' or 'host 207' in figures 1, 2), *said subscriber line interface circuit being arranged to transform a voice signal transmitted from said terminal apparatus into a digital signal and to transform a digital signal received from a control circuit into an in-coming voice signal* (for example see col. 4, lines 54-64; col. 5, lines 25-28); *placing said voice over internet protocol device in a preset operation mode* ('normal mode', 'Internet mode'; for example see col. 4, lines 43-46 where the relay 201 is on the 'no power default position 1' or 'power default position 2' as disclosed in col. 17, lines 7-20); *detecting an in-coming call ringing signal transmitted from said public switched telephone network* (for example see col. 17, lines 23-30).

Ng does not explicitly use the word "*employment status*"; however, Ng does disclose the detecting 'on-hook' and 'off-hook' of the phone by the off-hook detector for the PSTN line connection as disclosed in col. 18, lines 58-62; col. 19, lines 16-20, e.g. "*upon detection of an in-coming call ringing signal transmitted from the public switched telephone network, checking an employment status* ('on-hook', 'off-hook' in figure 9) *of at least one said terminal apparatus*

connected with said voice over internet protocol device; if at least one said terminal apparatus is unused ('on-hook'), *causing said line transfer switch to disconnect the unused terminal apparatus from the subscriber line interface and connect the unused terminal apparatus to a loop which is connected with said public switched telephone network, thereby disconnecting the terminal apparatus from the internet and transferring said in-coming ring signal from said public switched telephone network to said unused terminal apparatus* (for example see col. 18, line 58 through col. 19, line 20).

Thus it would have been obvious to the person of ordinary skill in the art at the time of the invention was made to use the detecting 'on-hook' and 'off-hook' of the phone taught by Ng as "*unused*" or "*use*" of the "*employment status*", with the motivation being to provide the states of the phone in connecting with the PSTN as disclosed in detail of figure 9.

- Regarding claim 5, in addition to features in base claim 4 (see rationales pertaining the rejection of base claim 4 discussed above), Ng further discloses, *wherein when the ringing signal disappears and said terminal apparatus is in unused status again, said voice over internet protocol device causes said terminal apparatus to be transferred back to a connection with said subscriber line interface circuit to re-connect said terminal apparatus with the internet through said subscriber line interface circuit* (for example see details of figure 9 with 'on-hook' state; col. 17, lines 35-38; col. 18, lines 46-49; col. 19, lines 16-18).

- In regard to claim 6, in addition to features in base claim 4 (see rationales pertaining the rejection of base claim 4 discussed above), Ng further discloses, *wherein said voice over internet*

protocol device detects a phone number dialed in said terminal apparatus to judge that the phone corresponding to said phone number dialed in said terminal apparatus belongs to the public switched telephone network or the internet phone, such that said voice over internet protocol device selectively transfers said terminal apparatus between a status which connects said terminal apparatus with said loop and a status which connects said terminal apparatus with said subscriber line interface circuit depending on whether said phone number dialed in said terminal apparatus is a phone number of a phone on the public switched telephone network or the internet phone (for example see col. 17, lines 23-30, 41-45 wherein the difference of dialed sequence DTMF digits of the phone number between the Internet and PSTN are disclosed in col. 18, lines 17-30).

Response to Amendment/Arguments

6. Applicant's arguments filed on November 16th, 2005 have been fully considered but they are not persuasive.

In the REMARKS, pages 7-9, Applicant argues that the connecting telephone call to the PSTN of Ng's reference is required connection to an Internet service provider ISP. Examiner respectfully disagrees, because there is no such language in the claim to exclude the use of the Ng's reference. Applicant also argues that Ng does not have any independent network interface circuit for converting voice signals from the telephone to Internet-ready packets. Examiner respectfully disagrees. Ng does disclose the telephone network interface circuitry including the relay 201 ("*transfer switch*", see figures 2 and 8), the audio interface circuitry ("*SLIC*" see figures 2, 8; col. 4, lines 54-64), Internet processor ("*control circuit*", see figure 2) in the Internet

phone 103, e.g. "*independent network interface circuit*", as disclosed in figures 1-2 and 8; col. 4, lines 54-64; col. 5, lines 25-39; for converting audio signal to the suitable digital signal format for transmission over the Internet 104 as disclosed in figure 1; col. 4, lines 5-8.

Applicant further argues that Ng does not disclose the detection of "*employment status*" for supplying a transfer signal to the transfer switch in automatic connecting unused phones to PSTN. Examiner respectfully disagrees. Ng does disclose the detecting 'on-hook' and 'off-hook' of the phone ("*employment status*") by the off-hook detector for the PSTN line connection as disclosed in col. 18, lines 58-62; col. 19, lines 16-20; in order to connect and switch the phone with the on-hook state, e.g. "*unused phone*", to PSTN by the relay 201 (see details in figure 9). Ng further discloses the ring detection for incoming PSTN or Internet calls (see col. 17, lines 23-30, 41-45; wherein the difference of dialed sequence DTMF digits of the phone number between the Internet and PSTN are disclosed in col. 18, lines 17-30).

Lastly, Applicant argues that Ng does not disclose the switching between the Internet and PSTN in case of a temporary power failure. However, there is no such claimed language in claims 4-6.

Therefore, Examiner concludes that Ng teaches the arguable features.

Allowable Subject Matter

7. Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Claims 1-3 are allowed. The following is a statement of reasons for the indication of allowable subject matter:

Many references in the art disclose the method for connecting telephone call to the PSTN or Internet. But no prior art reference utilizes the method for switching between SLIC and PSTN in case of power failure.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

9. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri H. Phan, whose telephone number is (571) 272-3074. The examiner can normally be reached on M-F (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi H. Pham can be reached on (571) 272-3179.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(571) 273-8300

Hand-delivered responses should be brought to Randolph Building, 401 Dulany Street, Alexandria, VA 22314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office, whose telephone number is (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tri H. Phan
March 17, 2006

CHI PHAM
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER

3/17/06